UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,582	04/04/2002	Steve Vestergaard	119.5-US-WO	5988

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OYEN, WIGGS, GREEN & MUTALA LLP		TO, BAOTRAN N
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VANCOUVER, BC V6B 1G1		
CANADA	2135	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	09/980,582	VESTERGAARD ET AL.
	Examiner	Art Unit
	Baotran N. To	2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 November 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-6, 11, 17, 18, 20, 21, 25, 27, 28, 31, 33-44, 46 and 54</u> is/are pending in the application.

    4a) Of the above claim(s) <u>7-10, 12-16, 19, 22-24, 26, 29, 30-32 and 45</u> is/are ~~withdrawn from consideration.~~ *canceled.*

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-6, 11, 17, 18, 20, 21, 25, 27, 28, 31 and 33-44, 46 and 54</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action responds to the Applicant's Amendment filed on 11/17/2006.

Claims 1-6, 11, 17-18, 20-21, 25, 27-28, 31 and 33 are amended, Claims 7-10, 12-16,

19, 22-24, 26, 29, 30-32 and 45 are cancelled, and Claims 47-54 are new.

Claims 1-6, 11, 17, 18, 20, 21, 25, 27, 28, 31, 33-44, 46 and 54 remain for

examination.

Response to Arguments

2.   Applicant's arguments with respect to Claims 1-6, 11, 17, 18, 20, 21, 25, 27, 28,

31, 33-44, 46 and 54 have been considered but are moot in view of the new ground(s)

of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

3.   Claims 1, 3, 17, 21, 25, 36-39, 14-39, 41-42 and 46-50 are rejected under 35

U.S.C. 103(a) as being unpatentable over Glover (U.S. Patent 6,052,780) herein

referred to as Glover and in view of En-Seung et al. (U.S. Patent 6,892,306 B1) herein

referred to as En-Seung.

Regarding Claims 1 and 46, Glover discloses a method of distributing electronic

media, the method comprising:

receiving a file (computer program) (col. 4, lines 30-35) at a user computing

device,

the file comprising an integral decryption engine (decryption program) and

encrypted media content (encrypted digital information) (col. 3, lines 45-50 and col. 20,

lines 15-35),

requesting a decryption key (key) from a remote server (content provider) (col. 3,

lines 45-50, col. 21, lines 20-65 and col. 22, lines 1-10).

Glover explicitly does not disclose "receiving the decryption key from the remote

server at the user computing device, the decryption key itself encrypted at the remote

server with a user key, the user key bonded to the user computing device by being

based at least in part on one or more characteristics of the user computing device such

that the user computing device can use the user key to decrypt the decryption key."

However, En-Seung clearly discloses receiving the decryption key (temporary

validation key) from the remote server at the user computing device (col. 7, lines 52-61),

the decryption key itself encrypted at the remote server with a user key (user's key) (col.

6, lines 30-36), the user key bonded to the user computing device by being based at

least in part on one or more characteristics of the user computing device such that the

user computing device can use the user key to decrypt the decryption key (col. 7, lines

6-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have incorporated En-Seung's invention with Glover to

include receiving the decryption key from the remote server at the user computing

device, the decryption key itself encrypted at the remote server with a user key, the user

key bonded to the user computing device by being based at least in part on one or more

characteristics of the user computing device such that the user computing device can

use the user key to decrypt the decryption key. One of ordinary skill in the art would

have been motivated to prevent an individual from making a useful copy of the

information (col. 2, lines 20-23 of Glover).

Glover and En-Seung disclose the limitations as discussed in Claim 1 above.

Glover further discloses responding to receipt of said decryption key from said remote

server at the user computing device by: decrypting said media content at the user

computing device using said integral decryption engine and the decryption key (col. 3,

lines 45-50 and col. 21, lines 45-65).

Regarding Claim 3, Glover and En-Seung disclose the limitations as discussed in

Claim 1 above. Glover further discloses after decrypting the media content, viewing

said media content by executing external viewer software linked to said file (col. 21,

lines 20-60).

Regarding Claim 17, Glover discloses the limitations as discussed in Claim 35

above. Glover further discloses wherein the file is executable independently of other

programs and wherein requesting the decryption key and decrypting the media content

are accomplished by executing the file (col. 21, lines 45-50).

Regarding Claim 21, Glover discloses the limitations as discussed in Claim 3

above. Glover further discloses wherein decrypting the media content and viewing the

media content are accomplished without storing a decrypted copy of the media content

locally (col. 6, lines 55-65).

Regarding Claim 25, Glover discloses the limitations as discussed in Claim 24

above. Glover further discloses wherein downloading the file from the second user

comprises using a peer to peer network (col. 22, lines 10-20).

Regarding Claim 34, Glover and En-Seung disclose the limitations as discussed

in Claim 1 above. En-Seung further discloses generating the user key at the user

computing device (col. 6, lines 58-63).

Regarding Claim 35, Glover and En-Seung disclose the limitations as discussed

in Claim 34 above. En-Seung further discloses wherein decrypting the media content at

the user computing device using the integral decryption engine and the decryption key

comprises using the user key to decrypt the decryption key and to thereby obtain a

decrypted decryption key (col. 16, lines 20-30).

Regarding Claim 36, Glover and En-Seung disclose the limitations as discussed in Claim 35 above. En-Seung further discloses wherein using the user key to decrypt the decryption key is performed without storing the decrypted decryption key in memory accessible to a user of the user computing device (col. 12, lines 22-30).

Regarding Claim 37, Glover and En-Seung disclose the limitations as discussed in Claim 35 above. Glover further discloses after decrypting the media content, viewing said media content by executing viewer software, the viewer software also integral with said file (col. 21 lines 1-45).

Regarding Claim 38, Glover and En-Seung disclose the limitations as discussed in Claim 36 above. En-Seung further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content in memory accessible to a user of the user computing device (col. 3, lines 35-50).

Regarding Claim 39, Glover and En-Seung disclose the limitations as discussed in Claim 37 above. Glover further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content in memory accessible to a user of the user computing device (col. 4, lines 30-65).

Regarding Claim 41, Glover and En-Seung disclose the limitations as discussed in Claim 35 above. En-Seung further discloses wherein receiving the file at the user computing device comprises downloading the file using a peer to peer network (col. 3, lines 5-18).

Regarding Claim 42, Glover and En-Seung disclose the limitations as discussed in Claim 1 above. En-Seung further discloses wherein decrypting the media content at the user computing device using the integral decryption engine and the decryption key comprises using the user key to decrypt key and to thereby obtain a decrypted decryption key (col. 6, lines 55-65).

Regarding Claim 47, Glover and En-Seung disclose the limitations as discussed in Claim 1 above. En-Seung further discloses wherein receiving the file at the user computing device comprises receiving the file from a computer that is different from the remote server from which the decryption key is received (Figures 3 and 4).

Regarding Claim 48, Glover and En-Seung disclose the limitations as discussed in Claim 1 above. En-Seung further discloses sending the file from the user computing device to a second user computing device; upon receipt of the file at the second user computing device; sending a request, from the second user computing device to the remote server, for the decryption key; receiving the decryption key from the remote server at the second user computing device, the decryption key itself encrypted at the

remote server with a second user key, the second user key bonded to the second user

computing device by being based at least in part on one or more characteristics of the

second user computing device such that the second user computing device can use the

second user key to decrypt the decryption key; and responding the receipt of the

decryption key from the remote server at the second user computing device by

decrypting the media content at the second user computing device using the integral

decryption engine and the decryption key (col. 6, lines 30-36, col. 7, lines 6-16 and 52-

61).

Regarding Claim 49, Glover and En-Seung disclose the limitations as discussed

in Claim 48 above. En-Seung further discloses after receiving the file at the second user

computing device, generating the second user key at the second user computing device

(col. 6, lines 59-63).

Regarding Claim 50, Glover and En-Seung disclose the limitations as discussed

in Claim 49 above. En-Seung further discloses wherein decrypting the media content at

the second user computing device using the integral decryption engine and the

decryption key comprises using the second user key to decrypt the decryption key and

to thereby obtain a decrypted decryption key (col. 5, lines 20-25).

4.   Claims 4-6, 11, 28, 31, 43-44 and 51-54 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Glover (U.S. Patent 6,052,780) herein referred to as Glover in

view of Budge et al. (U.S. Patent 6,564,248 B1) herein referred to as Budge and further

in view of En-Seung et al. (U.S. Patent 6,892,306 B1) herein referred to as En-Seung.

Regarding Claim 4, Glover discloses a method of managing distribution of

proprietary electronic media, the method comprising:

receiving a single file (computer program) at a user computing device (col. 4,

lines 30-35), the file comprising an integral decryption engine and encrypted media

content (encrypted digital information) (col. 3, lines 45-50), but Glover explicitly does not

disclose "integral media playback software."

However, Budge expressly discloses integral media playback software (col. 2,

lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have incorporated Glover's invention with Budge to

provide integral media playback software. One of ordinary skill in the art would have

been motivated to allow the receiving system to view the video file without necessity of

previously installing special software at the receiving system (col. 6, lines 15-20).

Glover and Budge disclose the limitations of Claim 4 above. Furthermore, Glover

discloses the single file executable independently of other program to:

decrypt the media content using the integral decryption engine and a decryption

key obtained separately from the file (col. 3, lines 45-50 and col. 21, lines 20-65); and

Budge explicitly discloses view the media content using the integral media playback

software (col. 6, lines 15-20).

Glover and Budge explicitly do not disclose "obtain the decryption key from a remote server, the decryption key itself encrypted at the remote server with a user key, the user key bonded to the user computing device by being based at least in part on one or more characteristics of the user computing device such that the user computing device can use the user key to decrypt the decryption key."

However, En-Seung clearly discloses obtain the decryption key (temporary validation key) from a remote server (service server) (col. 7, lines 52-61), the decryption key itself encrypted at the remote server with a user key (users' key) (col. 6, lines 30-36), the user key bonded to the user computing device by being based at least in part on one or more characteristics of the user computing device such that the user computing device can use the user key to decrypt the decryption key (col. 7, lines 6-16).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated En-Seung's invention with Glover and Budge to include obtain the decryption key from a remote server, the decryption key itself encrypted at the remote server with a user key, the user key bonded to the user computing device by being based at least in part on one or more characteristics of the user computing device such that the user computing device can use the user key to decrypt the decryption key. One of ordinary skill in the art would have been motivated to prevent an individual from making a useful copy of the information (col. 2, lines 20-23 of Glover).

Regarding Claim 5, Glover, Budge and En-Seung disclose the limitations as discussed in Claim 4 above. Glover further discloses wherein downloading the single file comprises downloading said single file from a remote server via a communication network (col. 21, lines 5 and col. 22, lines 15-20).

Regarding Claim 6, Glover, Budge and En-Seung disclose the limitations as discussed in Claim 5 above. Glover further discloses downloading said decryption key from said remote server via said communication network (col. 21, lines 60-65 and col. 22, lines 1-10).

Regarding Claim 11, Glover, Budge and En-Seung disclose the limitations as discussed in Claim 6 above. Glover further discloses wherein said remote server tracks a number of decrypting key downloads relating to the single file (col. 21, lines 5-10).

Regarding on Claim 28, Glover, Budge and En-Seung disclose the limitations as discussed in Claim 4 above. Glover further discloses wherein the single file is executable to view the media content using the integral media playback software without storing a decrypted copy of the media content in memory accessible to a user of the user computing device (col. 20, lines 55-67).

Regarding Claim 31, Glover, Budge and En-Seung disclose the limitations as discussed in Claim 4 above. Glover further discloses wherein server tracks a number of

decryption keys relating to the single file that have been issued by the remote server

(col. 21, lines 5-10).

Regarding Claim 43, Glover, Budge and En-Seung disclose the limitations as

discussed in Claim 4 above. En-Seung further discloses wherein execution of the single

file causes the user computing device to generate the user key at the user computing

device (col. 6, lines 59-63).

Regarding Claim 44, Glover, Budge and En-Seung disclose the limitations as

discussed in Claim 43 above. En-Seung further discloses wherein execution of the

single file to decrypt the media content using the integral decryption engine and the

decryption key comprises using the user key to decrypt the decryption key and to

thereby obtain a decrypted decryption key (col. 5, lines 20-25).

Regarding Claim 51, Glover, Budge and En-Seung disclose the limitations as

discussed in Claim 6 above. En-Seung further discloses wherein the computer is

different from the remote server from which the decryption key is obtained (Figures 3

and 4).

Regarding Claim 52, Glover, Budge and En-Seung disclose the limitations as

discussed in Claim 4 above. En-Seung further discloses sending the file from the user

computing device to a second user computing device; upon receipt of the file at the

second user computing device; sending a request, from the second user computing

device to the remote server, for the decryption key; receiving the decryption key from

the remote server at the second user computing device, the decryption key itself

encrypted at the remote server with a second user key, the second user key bonded to

the second user computing device by being based at least in part on one or more

characteristics of the second user computing device such that the second user

computing device can use the second user key to decrypt the decryption key; and

responding the receipt of the decryption key from the remote server at the second user

computing device by decrypting the media content at the second user computing device

using the integral decryption engine and the decryption key (col. 6, lines 30-36, col. 7,

lines 6-16 and 52-61).

Regarding Claim 53, Glover, Budge and En-Seung disclose the limitations as

discussed in Claim 52 above. En-Seung further discloses after receiving the file at the

second user computing device, generating the second user key at the second user

computing device (col. 6, lines 59-63).

Regarding Claim 54, Glover, Budge and En-Seung disclose the limitations as

discussed in Claim 53 above. En-Seung further discloses wherein decrypting the media

content at the second user computing device using the integral decryption engine and

the decryption key comprises using the second user key to decrypt the decryption key

and to thereby obtain a decrypted decryption key (col. 5, lines 20-25).

5.   Claims 2, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Glover as applied to claim 1 above, and further in view of Glover in view of Budge

et al. (U.S. Patent 6,564,248 B1) herein referred to as Budge.

        Regarding Claim 2, Glover and En-Seung disclose the limitations as discussed in

Claim 1 above. Glover further discloses after decrypting the media content (col. 3, lines

45-50), but Glover and En-Seung explicitly do not disclose viewing said media content

by executing viewer software, the viewer software also integral with said file.

        However, Budge expressly discloses viewing said media content by executing

viewer software, the viewer software also integral with said file (col. 2, lines 25-30).

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have incorporated Budge's invention within Glover and

En-Seung to provide viewing said media content by executing viewer software, the

viewer software also integral with said file. One of ordinary skill in the art would have

been motivated to allow the receiving system to view the video file without necessity of

previously installing special software at the receiving system (col. 6, lines 15-20).

        Regarding Claim 18, Glover and En-Seung disclose the limitations as discussed

in Claim 17 above. Glover and En-Seung do not disclose wherein the file also

comprises integral media player software.

However, Budge expressly discloses wherein the file also comprises integral media player software (col. 2, lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Budge's invention within Glover and En-Seung to provide wherein the file also comprises integral media player software. One of ordinary skill in the art would have been motivated to allow the receiving system to view the video file without necessity of previously installing special software at the receiving system (col. 6, lines 15-20).

Regarding Claim 20, Glover, En-Seung and Budge disclose the limitations as discussed in Claim 2 above. Glover further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content locally (col. 20, lines 55-67).

6.   Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glover, Budge, and En-Seung as applied to claim 4 above, and further in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding Claim 33, Glover, Budge and En-Seung disclose the limitations as discussed in Claim 4 above. Glover, Budge and En-Seung explicitly do not disclose wherein a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key.

However, Wiser expressly discloses a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key (col. 3, lines 50-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention within Glover, Budge and En-Seung to provide a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key. One of ordinary skill in the art would have been motivated to allow the consumer has the opportunity to watch the portion of the video program before ordering (col. 3, lines 55-60).

7.   Claims 27 and 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glover and En-Seung as applied to claims 1 and 35 above, and further in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding Claims 27 and 40, Glover and En-Seung disclose the limitations as discussed in Claim 4 above. Glover and En-Seung explicitly do not disclose wherein a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key.

However, Wiser expressly discloses a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key (col. 3, lines 50-60).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention within Glover and En-Seung to provide a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key. One of ordinary skill in the art would have been motivated to allow the consumer has the opportunity to watch the portion of the video program before ordering (col. 3, lines 55-60).

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
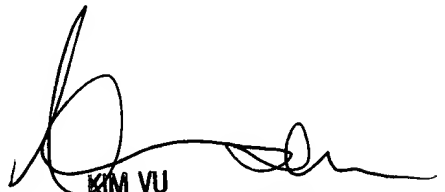
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Baotran N. To whose telephone number is 571-272-
8156. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the
organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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BT
01/24/2007

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